



## THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re US National Phase Patent Application in respect of International Patent Application number PCT/IB02/02923 in the name of Frederick Roelof VAN RENSBURG

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STATEMENT IN SUPPORT OF PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R.' 1.137(b)

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I,

Frederick Roelof VAN RENSBURG,

hereby state as follows:

1. I am the applicant of the abovementioned patent application.
2. I am the inventor of an invention entitled "Loss of value". I filed PCT/IB02/02923 (the "International application") on 26 July 2002, claiming priority from an earlier South African patent application No 2001/6311 filed on 31 July 2001 in the name of Quickstep 313 (Proprietary) Limited, ("Quickstep") a South African company of which I am a shareholder. My agent for the International application was Alan Lewis, a patent attorney of Adams & Adams, 3<sup>rd</sup> Floor, 23 Wellington Road, Parktown, Gauteng, South Africa. My agent acts on the instructions of Quickstep. Mr Nicolaas Johannes Nel is a director of Quickstep and most communications between my agent and Quickstep take place via him. Any reference hereafter to "we" is meant to refer collectively to me and Quickstep.

3. In January 2003 my agent wrote to Quickstep. I attach hereto, marked "FRVR1" a copy of a fax from Adams & Adams to Quickstep. It will be seen therefrom that the Search Report had not been received and we were informed that International Preliminary Examination had to be requested by 27 February 2003. Examination was timeously requested. I understood from Mr Nel that the matter would then remain pending until the PCT application had been examined.
4. Our agent was also requested to investigate with the US Patent Office ("USPTO") when the Search Report would issue. In this regard I attach marked "FRVR2" a copy of an email from Mr S Meyers, of the USPTO, dated January 14, 2003, and a copy of an email from our agent to the USPTO dated February 24, 2003, marked "FRVR3".
5. Thereafter, the USPTO mailed the Search Report on March 12, 2003. Our agent reported the Search Report on April 4, 2003. A copy of our agent's fax is attached marked "FRVR4". It will be noted therefrom that our agent did not say anything, at that time, in regard to the filing of national phase applications.
6. We subsequently received an email from our agent on March 9, 2004, a copy of which is attached marked "FRVR5". It will be seen therefrom that we were informed that "the deadline for filing most (my underlining) national phase applications has now passed". I understood this to mean that we could still file in the USA.
7. Mr Nel responded with an email of March 19, 2004, a copy of which is attached marked "FRVR6". I refer to the statement therein which reads "Please let me know if there is in any way a chance for us to register this product overseas, even if it can only be done in the USA." I respectfully submit that it is clear therefrom that it was our understanding that the matter was still pending in the US.



8. The email response from our agent dated March 23, 2004 is attached marked "FRVR7". In this email we were told that it was no longer possible to obtain patent protection for my invention in the US.
9. In the light thereof, and not knowing if the invention was patentable, we took no action.
10. To our surprise, we received a further email dated October 29, 2004 from our agent reporting that a Written Opinion had been received. A copy of the email is attached marked "FRVR8". I refer in particular to paragraph 5 thereof where our agent raises the possibility of an extension being obtained. We instructed our agent to prepare and file a response to the Written Opinion.
11. A response was filed on November 5, 2004. I attach further a copy of an email from our agent dated November 5, 2004 is attached marked "FRVR9". It will be noted from paragraph 2 thereof that our agent did not check if it was still possible to file a national phase application in the US.
12. It appears that our agent misunderstood Mr Nel's instructions and Mr Nel sent him an email on November 11, 2004, a copy of which is attached marked "FRVR10". It will be seen therefrom that we queried what would happen if the response from the USPTO was favourable, and asked for an estimate of costs.
13. Mr Nel was then informed telephonically on November 15, 2004 that it would cost about R5,000 to R10,000 to check if a US patent application could still be filed and in the region of R25,000 to R30,000 to file an application. In the light thereof it was decided to wait for the reaction of the USPTO PCT examiner.
14. On June 1, 2005 my agent forwarded to us an International Preliminary Examination Report ("IPER") issued by the USPTO on May 23, 2005. He advised



us further that, insofar as the United States was concerned, he had been informed that the USPTO regarded the application as having lapsed due to the failure to file a United States national phase application within the 30 month deadline, notwithstanding that the IPER had only just been issued, but that there was a mechanism for applying for the revival of an unintentionally abandoned application. It was only then that we became aware that the USPTO would in fact not grant us an extension within which to file a US national phase application on the basis of the late issuance of the IPER.

15. My agent was instructed to obtain further information about the procedure for launching a petition to revive the application, which he did, and he reported to us thereon on June 7, 2005.

16. He was thereafter instructed by Quickstep immediately to prepare and file a petition for the revival of an unintentionally abandoned patent application as well as a US national phase application.

17. I submit that the lapsing of the application was unintentional and that had we known in January 2004 that a US national phase application had to be filed within the 30 month deadline of January 31, 2004, notwithstanding that the IPER had not been issued, we would definitely have done so. Moreover, we were not aware until 7 June 2005 that the correct procedure for reviving the application in the United States would have been immediately to file a US national phase application and a petition to revive the application. If we had known this we would have done so immediately since we regard patent protection in the US as being valuable and important.

*FAR*

18. In the circumstances I request that the application be revived.

Signed at JOHANNESBURG this <sup>th</sup> day of JUNE 2005.

A handwritten signature in black ink, appearing to read 'F.R. van Rensburg', written over a horizontal line.

Frederick Roelof VAN RENSBURG

**FA: TRANSMISSION**  
**FROM: (011) 642-1914**

**FRVR1**

No of pages transmitted: (3) (including this page)  
Confirmation copy by post

To Fax No: (012) 809-2960

Quickstep 313 (Pty) Ltd  
PO Box 1864  
PRETORIA  
0001

V14764 AL/DM  
Mr Lewis

13 January 2003

Attention: Mr N Nel

Dear Sirs

International Patent Application No. PCT/IB02/02923 in the name of VAN  
RENSBURG, Frederick Roelof - " AN INSURANCE PRODUCT " -  
Our Ref: F16713 AL/DM

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1. We refer to previous correspondence in this matter, ending with our letter to you of 9 September 2002.

2. SEARCH REPORT

We have not yet received the International Search Report notwithstanding that, according to the PCT regulations, the international search report should have already been issued. We are following up the matter with the International Searching Authority, in this case the United States Patent and Trademark Office, and shall report further to you in this regard.

3. FURTHER PROSECUTION

3.1 You now have to decide whether or not you wish to enter into Chapter II proceedings of the PCT. In order to enter into Chapter II proceedings you will have to file a request for International Preliminary Examination by no later than 27 February 2003. This deadline is unextendable, and applies regardless of whether or not you have by then received the International Search Report. We estimate that the cost of requesting an International Preliminary Examination will be in the region of R10 000 - R12 000. This does not include our costs incurred to date since our last invoice nor our anticipated costs for attendances in relation to the International Search Report. The International Examining Authority, in this case the

*Fell*

United States Patent and Trademark Office, will then examine your invention on its merits with reference to any prior art which may be cited in the International Search Report, and will issue a Written Opinion. At that stage, you may choose to respond to the Written Opinion, which may include amending the specification and claims, to overcome any objections which the Examiner may raise. We estimate that the cost of responding to a Written Opinion may be in the region of R20 000. Thereafter, the Examiner will issue an International Preliminary Examination Report.

3.2 Regardless of whether or not you request International Preliminary Examination, you will have to file national and/or regional phase patent applications in order to prosecute your patent application further in the countries where you require protection. Subject to what is said below, the relevant deadlines for filing national phase applications and/or regional phase applications are usually 30 months (in certain cases 31 months or more) after the priority date of 31 July 2001 i.e. 31 January 2004. Currently, the cost of filing national phase applications in English speaking countries is usually about R20 000 - R35 000, and in non-English speaking countries may be up to R70 000. We shall be able to give you closer estimates of the filing costs in particular countries in which you may be interested, upon request.

3.3 Certain countries, however, currently require that if you do not file a request for International Preliminary Examination, you must file a national phase application by no later than 20 months (in certain cases 21 months) after the priority date i.e. by 31 March 2003. These countries are :

- (i) Brazil, China, Estonia, Hungary, Republic of Korea, Norway and Singapore; and
- (ii) Switzerland, Denmark, Finland, Luxembourg, Sweden, Tanzania, Uganda and Zambia.

For countries referred to in (ii), it is possible, instead of filing a national phase application within the deadline referred to above, to file regional phase applications at an applicable regional patent office. The deadlines for filing patent applications at the regional patent offices are 30 or 31 months after the priority date, depending on which regional patent office is concerned.

3.4 Should you request International Preliminary Examination, then the deadline for filing national phase applications for the countries referred to in (i) and (ii) above will be 30 months (in certain cases 31 months) after the priority date. Accordingly, an advantage of filing a request for International Preliminary Examination is that you shall obtain an extended time period within which to file national phase applications for the countries referred to in (i) and (ii) above.

3.5 Another possible benefit of requesting International Preliminary Examination is that a positive Examination Report may facilitate the prosecution of



**From:** <Steven.Meyers@USPTO.GOV>  
**To:** <deborah-m@adamsadams.co.za>  
**Date:** Tuesday, January 14, 2003 9:49PM  
**Subject:** IB02/02923

FRVR 2

Deborah, we found the case and it had recently passed it's due date, so we took it out of turn and forwarded it along to get a few clerical items done prior to it going to the examiner. We have set a new due date of January 28, 2003 for the examiner to get the Search Report done. Hopefully this e-mail will get to you, and if it does it may be easier (and cheaper) to e-mail me back if you have any further questions. Thanks,

Steve Meyers  
Special Programs Examiner  
Technology Center 3600  
(703) 308-3868

Fork



FRVR3

**From:** Deborah MARSICANO  
**To:** Steven.Meyers@USPTO.GOV  
**Date:** 2/24/03 1:33PM  
**Subject:** PCT Application IB02/02923 in the name of F R Van Rensburg- "An Insurance Product"-Our Ref: F16713AL

Further to your e-mail of 14 January 2003, a copy of which is attached hereto, please confirm when we may expect to receive the Search Report.

We thank you for your assistance.

Alan Lewis  
Adams & Adams

P O Box 10155  
Johannesburg  
2000  
Tel: 27 11 642 5057  
Fax: 27 11 642 1914

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>>> <Steven.Meyers@USPTO.GOV> 01/14/03 09:49PM >>>  
Deborah, we found the case and it had recently passed it's due date, so we took it out of turn and forwarded it along to get a few clerical items done prior to it going to the examiner. We have set a new due date of January 28, 2003 for the examiner to get the Search Report done. Hopefully this e-mail will get to you, and if it does it may be easier (and cheaper) to e-mail me back if you have any further questions. Thanks,

Steve Meyers  
Special Programs Examiner  
Technology Center 3600  
(703) 308-3868

Full

**FAX TRANSMISSION  
FROM: (011) 642-1914****FRVR4**

No of pages transmitted: (7) (including this page)  
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To Fax No: (012) ~~908-2986~~ 979 - 6901

Quickstep 313 (Pty) Ltd  
PO Box 1864  
PRETORIA  
0001

F16713 AL/DM  
Mr Lewis

4 April 2003

Attention: Mr N Nel

Dear Sirs

International Patent Application No. PCT/IB02/02923 in the name of **VAN RENSBURG, Frederick Roelof - " AN INSURANCE PRODUCT "**  
Our Ref: F16713 AL/DM

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1. We refer to previous communications in this matter, ending with the telephone discussion on 4 April 2003 between Mr Grobbelaar and the writer.
2. We confirm having received the International Search Report issued by the United States Patent Office for the above PCT patent application. We enclose herewith a copy of the Search Report. The prior art cited in this Search Report follows with the confirmatory copy of this letter.
3. You will note that seven documents have been cited, namely three patent specifications being US 4,831,526 (Luchs et al), US 5,682,488 (Gleason et al) and US 5,897,619 (Hargrove, Jr. et al) as well as four other publications being
  - 'Filling Insurance 'Gap' for Drivers who Lease', San Francisco Chronicle;
  - 'TIL Insurance Option Breeds Trouble' (Thomas et al);
  - 'Crop Revenue Insurance' (Hofstrand); and
  - 'Crop and Revenue Insurance: Bargain Rates but Still Hard to Sell' (Schnepf).
4. We have not incurred the costs of studying the Search Report in detail and will only do so on your instructions. You will note that the searcher has cited prior art against all of the claims. The searcher is of the view that the Luchs et al patent, the San Francisco Chronicle article and the Thomas et al publication are of particular relevance with regard to inventiveness. The searcher considers the

*Full*

Gleason et al publication, the Hargrove, Jr. et al publication, the Hofstrand publication and the Schnepf publication as not being of particular relevance but nonetheless defining the general state of the art.

5. Since the examiner will probably question the inventiveness of the invention in the light of the prior art cited in the Search Report, we suggest that you read the documents carefully and furnish us with your comments thereon with regard to possible elements which are capable of distinguishing your invention from those cited in the Search Report and which are commercially important.

6. We await your further response in due course. Our tax invoice for our services to date in this matter will follow shortly.

Yours faithfully  
**ADAMS & ADAMS**

**ALAN LEWIS**

Encl.

*FWR*

From: Deborah MARSICANO  
To: nickynel@telkomsa.net  
Date: 09-Mar-04 2:00:07 PM  
Subject: International Patent Application No. PCT/IB02/02923 in the name of VAN RENSBURG, Frederick Roelof - "AN INSURANCE PRODUCT"

FRVRS

E-mail: nickynel@telkomsa.net

Confirmation copy by post

Quickstep 313 (Pty) Ltd  
PO Box 1864  
PRETORIA  
0001

Attention: Mr N Nel

Our Ref: F16713 AL/DM  
Mr Lewis

Our Ref:  
Dear Sirs

International Patent Application No. PCT/IB02/02923 in the name of VAN RENSBURG, Frederick Roelof - "AN INSURANCE PRODUCT" - Our Ref: F16713 AL/DM

1. We refer to previous communications in this matter ending with our e-mail to you of 18 June 2004 and, in particular, to our letters to you of 13 January 2003 and 4 April 2003.
2. Kindly note that the deadline for filing most national phase applications has now passed and accordingly, in the absence of any further instructions from you, we are now closing our file.

Yours faithfully  
ADAMS & ADAMS

ALAN LEWIS

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Feal

27. JUN. 2005 16:24

ADAMS & ADAMS JHB

NO. 720 P. 6

>>> "Nicky & Isabel Nel" <nickyne1@telkomsa.net> 19-Mar-04 12:02:40 PM >>>  
Dear Alan,

FRVR6

Thank you for the letter.

It is sad that we have not made any money on this fabulous product yet, but it will still come. The reason for no further instructions from us is the fact that we are still trying to pay the outstanding monies that we owe your company. The amount should be paid soon and there are a lot of things happening with the product but we are still not making money as yet. I have learned a lot about the insurance industry and how they operate in the last few years. We have made mistakes and it is clear to us that it will still take a while, but never say die.

Please let me know if there is in any way a chance for us to register this product overseas, even if it can only be done in the USA.

Thanks again for your help and support and please do not close this file, we are still going to need your help and expertise in the future.

Kind Regards,

Nicky

P.S. I have not yet received the e-mail dated 18 June 2004.

Fall

FRVR-7

**From:** Deborah MARSICANO  
nickynel@telkomsa.net  
**Date:** 23-Mar-04 3:22:50 PM  
**Subject:** International Patent Application No. PCT/IB02/02923 in the name of VAN RENSBURG, Frederick Roelof -

E-mail: nickynel@telkomsa.net

Confirmatory copy by post

Quickstep 313 (Pty) Ltd  
PO Box 1864  
PRETORIA  
0001

Attention: Mr N Nel

Our Ref: F16713 AL/DM  
Mr Lewis

Dear Nicky

International Patent Application No. PCT/IB02/02923 in the name of VAN RENSBURG, Frederick Roelof -  
"AN INSURANCE PRODUCT" - Our Ref: F16713 AL/DM

1. I refer to your e-mail to us of 19 March 2004.
2. Please note that in our previous e-mail to you our reference to "our e-mail to you of 18 June 2004" was meant to refer to our e-mail to you 18 June 2003 in relation to your outstanding account.
3. With regard to your query, please note that it is no longer possible to obtain patent protection for the invention in the United States.
4. If there is any other country in which you are specifically interested, then I can find out whether or not it is still possible to apply for patent protection, but I emphasize that in most countries of the world your invention is no longer patentable. The most notable countries, of which I am aware, where you can still apply for patent protection are Canada and Turkey. If you wish us to file patent applications in either of these countries, please let us know urgently.
5. Please note, however, that we cannot do any further work for you until you have paid the outstanding amount owing to us and that we shall, in addition, require appropriate cover for any further work which we may be required to do.

Yours faithfully  
ADAMS & ADAMS

ALAN LEWIS

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Deborah MARSICANO - International Patent Application No. PCT/IB02/02923

From: Deborah MARSICANO  
nickynel@telkomsa.net  
Date: 29-Oct-04 9:36:03 AM  
Subject: International Patent Application No. PCT/IB02/02923

FRVR8

E-mail: nickynel@telkomsa.net  
Confirmation copy by post

Quickstep 313 (Pty) Ltd  
PO Box 1864  
PRETORIA  
0001

Attention: Mr N Nel

Our Ref: F16713 AL/DM  
Mr Lewis

Dear Sirs

International Patent Application No. PCT/IB 02/02923 in the name of Frederick Roelof VAN RENSBURG -  
"LOSS OF VALUE" - Our ref: F16713 AL/DM

1. We refer to previous correspondence in the above matter, ending with our e-mail to you of 23 March 2004.
2. We have at last received a Written Opinion from the PCT examining authorities, being the United States Patent and Trademark Office ("USPTO"), on the patentability of the invention. A copy of the Written Opinion is enclosed herewith.
3. You will note that, in the Examiner's opinion, the invention, as claimed in claims 1 - 11 is anticipated by an article in the San Francisco Chronicle published on 1 August 1991 entitled "Filling Insurance 'Gap' For Drivers Who Lease". The Examiner is accordingly of the view that none of the claims are directed towards a patentable invention and that all of the claims are invalid.
4. Any reply to the Written Opinion must be filed by 8 November 2004. If no reply is filed, an International Preliminary Examination Report will be established on the basis of the Written Opinion.
5. However, as previously mentioned, the deadline for filing a national phase application in most countries has in any event long passed. However, it occurs to the writer that it might be possible to obtain an extension within which to file a national phase application in the United States on the basis that the USPTO is the Searching and Examining Authority and we have only now received the Written Opinion from the USPTO. It is our view that we shall not be able to obtain an extension, and it is our understanding that the invention has in any event not been a commercial success. However, if you wish us to investigate the issue further, please let us know. In the absence of your instructions we shall do nothing further.

Yours faithfully  
ADAMS & ADAMS

ALAN LEWIS

Encl. Written Opinion

Ful

FRVR9

**From:** Deborah MARSICANO  
**To:** tradeshield@telkomsa.net  
**Date:** 05-Nov-04 5:09:52 PM  
**Subject:** PCT Application NO. PCT/IB02/02923 - Our Ref: F16713 AL/DM

1. We refer to previous communications in this matter, ending with your telephone discussion with the writer on 3 November 2004.
2. In accordance with your instructions in your e-mail to su of 1 November 2004, we have proceeded with the filing of a response to the Written Opinion without checking whether it is still possible to file a national phase application in the US.
3. We enclose herewith our response to the Written Opinion, comprising amendments to the specification and claims, and submissions in support of the patentability of the invention as now described and defined in the claims, as amended. Copies of the amended pages in which the amendments have been marked up as well as clean copies of the amended pages are also attached.
4. We shall report further to you in due course.

Yours faithfully

Alan Lewis  
Adams & Adams

Adams & Adams  
P O Box 10155  
Johannesburg, 2000  
South Africa  
Tel: 27 11 642-5057  
Fax: 27 11 642-1914  
E-mail: deborah-m@adamsadams.co.za

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Ful



FRVR10

**Deborah MARSICANO - Re: PCT Application NO. PCT/IB02/02923 - Our Ref: F16713 AL/DM**

---

**From:** "Tradeshield" <tradeshield@telkomsa.net>  
**To:** "Deborah MARSICANO" <DEBORAH-M@adamsadams.co.za>  
**Date:** 11-Nov-04 12:38 PM  
**Subject:** Re: PCT Application NO. PCT/IB02/02923 - Our Ref: F16713 AL/DM

---

Dear Alan,

Thank you for filing the response to the Written Opinion as discussed previously. I have received your response with amendments and we are all sure that it will be successful this time.

I am, however, a little bit concerned that you have not checked whether it is still possible to file a national phase application in the US or not. I think that my instructions were then misunderstood because we said that it must be checked anyway. What will happen now if the USPTO's response is favourable, will we be able to file or not.

Please let me know and also include an estimate of what the costs will be if we can file a national phase application in the USA.

Thanks for the help and please phone me at any time if you need anything.

Kind Regards,

Nicky Nel

----- Original Message -----

**From:** Deborah MARSICANO  
**To:** tradeshield@telkomsa.net  
**Sent:** Friday, November 05, 2004 5:09 PM  
**Subject:** PCT Application NO. PCT/IB02/02923 - Our Ref: F16713 AL/DM

1. We refer to previous communications in this matter, ending with your telephone discussion with the writer on 3 November 2004.
2. In accordance with your instructions in your e-mail to su of 1 November 2004, we have proceeded with the filing of a response to the Written Opinion without checking whether it is still possible to file a national phase application in the US.
3. We enclose herewith our response to the Written Opinion, comprising amendments to the specification and claims, and submissions in support of the patentability of the invention as now described and defined in the claims, as amended. Copies of the amended pages in which the amendments have been marked up as well as clean copies of the amended pages are also attached.
4. We shall report further to you in due course.

Yours faithfully

Alan Lewis  
Adams & Adams